

U.S. Application Serial No.: 10/645,652  
Filed: August 20, 2003  
Docket No.: 10177-185-999  
CAM No.: 008563-999182  
Response to Office Action dated July 26, 2007

### REMARKS/ARGUMENTS

Claims 1-33 are currently pending in the present application, of which claims 6, 7, 16 and 20 have previously been withdrawn from consideration.

In the Office Action dated July 26, 2007 (the “Office Action”), the Examiner imposed a Restriction Requirement and requires an election under 35 U.S.C. § 121 to one of the following inventions:

- I. Claims 1-5, 8-14, and 29-33 drawn to an apparatus having microneedles capable of being ruptured, classified in class 604, subclass 96.01;
- II. Claims 15, 17-19 and 21-26, drawn to an apparatus having microneedles with lumens in fluid communication with an interior compartment of a balloon, classified in class 604, subclass 102.02; and
- III. Claims 27 and 28, drawn to an apparatus having microneedles disposed on a plate that is attached to a balloon wall, classified in class 604, subclass 99.01.

In response to the Restriction Requirement, Applicant hereby elects for further prosecution in this application, invention I of claims 1-5, 8-14, and 29-33, drawn to an apparatus having microneedles capable of being ruptured. This election is made *with traverse* and is made without prejudice to the Applicant’s right to file one or more divisional applications directed to the non-elected subject matter.

In the Office Action, the Examiner asserts that the inventions are independent and distinct from each other and therefore, there would be a serious burden on the Examiner if restriction is not required because the inventions require different fields of search. Applicant respectfully disagrees.

The M.P.E.P. § 811 (Eighth Edition, Revision 3, August 2005) states:

[b]efore making a restriction requirement after the first office action on the merits, the examiner will consider whether there will be a *serious* burden if restriction is not required.

(Emphasis added).

Applicant submits that to search the subject matter of inventions I, II, and III would not constitute a serious burden to the Examiner because inventions I, II, and III have been previously searched and examined during prosecution of the application, for example, see the

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Office Action dated December 12, 2006<sup>1</sup>. Further, in reply to the Office Action dated December 12, 2006, Applicant filed a response on May 11, 2007 that did not include amendments to the claims. Accordingly, because the scope of the claims did not change and because the claims have been previously searched and examined, Applicant respectfully submits that the Restriction Requirement is inappropriate. Thus, Applicant respectfully requests that: the requirement for restriction be withdrawn; inventions I, II, and III be examined together; and the May 11 response be considered.

The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

No other fees are believed due with this submission. However, should any fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

Respectfully submitted,

Date: August 24, 2007

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<sup>1</sup> Applicant would like to remind the Examiner that claims 27-33 were allowed in the December 12, 2006 Office Action.